

Application/Control Number: 09/781,445  
Art Unit: 2664

Docket No.: 112063CIP

### **REMARKS**

Reconsideration and allowance are requested. Claims 1 - 22 are presented and no claims are amended.

#### **The Requirement for the Examiner's Burden to Establish a Prima Facie Case of Obviousness**

The Examiner responds to Applicants argument regarding the Examiner's burden to establish a *prima facie* case of obviousness by citing In re Etter, 756 F.2d 852, 857 n. 5 (Fed. Cir. 1985). In essence, Applicants have articulated and cited the MPEP detailing the distribution of the burden of proof in the exchange of arguments between the Patent Office and Applicants. "The Examiner carries in initial burden of factually supporting any *prima facie* conclusion of obviousness." See MPEP 2142. In response, the Examiner has argued that it is not necessary to establish a prima facie case in order for "a substantial new question of patentability" to be present. The Examiner stated that "Thus, 'a substantial new question of patentability' as to a claim could be present even if the examiner would not necessarily reject the claim either as fully anticipated by, or obvious in view of, the prior art patents or printed publications." The Examiner points us to In re Etter for the differences between "a substantial new question of patentability" and a "prima facie" case of unpatentability.

Applicants respectfully submit that the legal analysis of "a substantial new question of patentability" is irrelevant to the present issue of patentability at this stage of prosecution. In re Etter is cited in the MPEP Section 2242 but this case relates to the issue of whether or not a re-examination is ordered. In re Etter sets forth the analysis of when a re-examination is to be ordered (which requires "a substantial new question of patentability") in contrast to prosecution in the first instance (in which the Examiner is bound by the burden to factually articulate a prima facie case of unpatentability). The re-examination standard requires a "a substantial new question of patentability" because the previous issue of patentability was

Application/Control Number: 09/781,445  
Art Unit: 2664

Docket No.: 112063CIP

already determined by the initial prosecution which is clearly evidenced by an issued patent which is now subject to a “new” question of patentability. As set forth in MPEP 2242, this standard requires both (1) teachings of the prior art that are important to deciding whether or not the claim is patentable (emphasis in original) and (2) that the same question of patentability as to the claim has not been decided by the office in a previous examination. Accordingly, the issue of a new question of patentability and the legal analysis associated with that question simply do not apply to the initial patentability analysis we are engaged in here (which is before the issuance of a patent which then becomes subject to the question of re-examination).

Applicants respectfully submit that if the analysis that the Examiner sets forth in this final office action were applied in this case or in general by the Patent Office, then it would eliminate the entire structure and burden allocating function of the *prima facie* process set forth in MPEP 2142. In this scenario, no Examiner would be required to establish or even articulate a *prima facie* case of obviousness but would merely need to state that a “a substantial new question of patentability” exists and then proceed to reject the claims. For this reason, Applicants respectfully request that the legal framework set forth by the MPEP be corrected in this record and applied in the present case. Applicants submit that this alone is reason enough to either allow this case or re-open the prosecution and issue a non-final office action in which the burden is appropriately met by the Examiner. Even in the outstanding Final Office Action, the Examiner has not adequately carried this burden. In the Final Office Action on page 6, line 14, the Examiner simply states that Kapoor et al. is “in the same field of endeavor”. There is no analysis related to the required articulation of why would one of skill in the art be motivated to combine these references.

Furthermore, in response to Applicants arguments regarding the lack of motivation or suggestion to combine and the lack of an articulated *prima facie* case of obviousness, the Examiner responded to arguments in Applicants April 14, 2005 Response at page 3, second

Application/Control Number: 09/781,445  
Art Unit: 2664

Docket No.: 112063CIP

paragraph and page 4, second paragraph. These are primarily arguments that relate to the teachings of the prior art but are not part of Applicants arguments about the motivation to combine. These arguments are found in the April 14, 2005 Response starting at page 4, third paragraph. In sum, Applicants have argued that (1) one of skill in the art would not be motivated to utilize the teachings of Kapoor relative to diversity combining techniques because Alamouti already teaches various kinds of diversity combining; and (2) Alamouti already teaches the RSSI and SINR channel selection method and Kapoor provides no additional insight or teachings regarding channel selection.

Rather than address the specific legal issue of motivation or suggestion, the Examiner on Page 4 notes again that Alamouti teaches the RSSI and SINR channel selection and that Kapoor again teaches a diversity combining (SDC) technique. The Examiner concludes on the bottom of page 4 that "this process is considered well known, and admitted as prior art." However, the MPEP, Section 2143.01, clearly states if a reference was individually "known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reasons to combine the teachings of the references." Furthermore, the Examiner must "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

Now, Applicants have argued that the Examiner has yet to carry the initial burden of providing a convincing and articulated line of reasoning for the motivation to combine these references. In addition, Applicants have set forth at least two clear rebuttal arguments above against sufficient motivation to combine. See April 14, 2005 Response. MPEP 2142 requires the Examiner to "reconsider the patentability of the claimed invention ... based upon consideration of all the evidence...." In so doing, the standard of evidence is only by a "preponderance of the evidence." As the record stands, Applicants have explained several

Application/Control Number: 09/781,445  
Art Unit: 2664

Docket No.: 112063CIP

reasons against the motivation to combine and the Examiner has only provided that the prior art processes are "well known" and that Kapoor is "in the same field" as Alamouti.

Accordingly, Applicants respectfully submit that by a preponderance of the evidence, Alamouti should not be combined with Kapoor. Therefore, claim 1 and its dependent claims are patentable. Similarly, since claims 2 - 22 each are rejected based on the combination of Kapoor with Alamouti, Applicants submit that these claims are patentable as well.

### CONCLUSION

Having addressed the rejection of claims, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

Date: December 12, 2005

By: /Thomas M. Isaacson/

Correspondence Address:  
Samuel H. Dworetsky  
AT&T Corp.  
Room 2A-207  
One AT&T Way  
Bedminster, NJ 07921

Thomas M. Isaacson  
Attorney for Applicants  
Reg. No. 44,166  
Phone: 410-414-3056  
Fax No.: 410-510-1433